

REMARKS

Applicant hereby traverses the current rejections and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1-13 and 15-38 are pending in this application.

Specification

In reviewing the specification, Applicant noted a grammatical error in the specification at paragraph [0030] and corrected this informality. No new matter has been entered.

Rejection Under 35 U.S.C. § 112

Claims 1-13, 15-22, and 29-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

With respect to claim 1, the Office Action states that the words “associated parameter” are indefinite because an entry in the authorization database may include more than one parameter. In response, Applicant has amended claim 1 to more clearly define the invention, specifically the claim now reads “the parameter of the entry associated with the user.” The claim has been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing its scope in the face of prior art. No new matter has been entered.

With respect to claim 8, the Office Action states that the limitation “wherein the parameter limits an ability of the associated user to evidence postage using the meter . . .” is indefinite because it is unclear (1) which parameter limits the user when there are more than one parameter and (2) which user of the plurality of users is the “associated user.” In response, Applicant has amended claim 8 to more clearly define the invention, specifically the claim now reads “wherein the parameter for the user limits an ability of the user associated with said parameter to evidence postage using the meter.” The claim has been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing its scope in the face of prior art. No new matter has been entered.

With respect to claim 15, the Office Action states that it is unclear who is the “selected user.” In response, Applicant has amended claim 15 to more clearly define the invention, specifically the claim now reads “the selected user associated with the postage usage parameter.” The claim has been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing its scope in the face of prior art. No new matter has been entered.

With respect to claim 29, the Office Action states that the phrase “said postage meter” lacks antecedent basis and it is unclear who “the selected user” recited throughout the claim is when there are a plurality of users. In response, Applicant has amended claim 29 to recite “a postage meter” and “the requesting user.” Thus, the phrase “a postage meter” now has proper antecedent basis. The claim has been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing its scope in the face of prior art. Claims 30-33 have been amended to correspond with the amendments made to independent claim 29. No new matter has been entered.

Accordingly, the rejections under 35 U.S.C. § 112, second paragraph, should be withdrawn.

Rejection Under 35 U.S.C. § 103

Claims 1-5, 7-11, 13, and 29-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,715,164 to Liechti, et al. (“*Liechti*”) in view of U.S. Publication No. 2002/0026430 to Ryan, JR. (“*Ryan*”).

The test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729 (2007). In *KSR*, the United States Supreme Court affirmed the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which must be considered in applying the statutory test: (1) determining of the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art, and (4) evaluate

evidence of secondary considerations. The current USPTO Guidelines incorporate the mandate of *Graham* and direct the Examiner to set forth in the Office Action the resolution of the factual inquires of *Graham* and provide a rationale to support the rejection. See M.P.E.P. § 2141. Therefore, the rejection must address all the limitations of the claims.

Lack of Limitations

Independent Claim 1

Claim 1, as now amended, defines a postage evidencing meter system that is operable to be used by a plurality of users. This system comprises an authorization database having a plurality of entries, wherein each entry is associated with a user of the plurality of users, and each entry includes at least one parameter, wherein the parameter limits an ability of the associated user to evidence postage using the meter. Neither *Liechti* nor *Ryan* nor the combination of cited prior art discloses at least these limitations. The Office Action admits that *Liechti* does not teach storing a plurality of entries as claimed. See Office Action, ¶ 18. Instead, the Office Action relies upon *Ryan* as disclosing this feature, in that it describes storing a plurality of customer account files in an account database in a mailpiece processing system, wherein each account file is associated with a different customer. See Office Action, ¶ 19. Applicant respectfully disagrees and notes that while *Ryan* teaches having a plurality of accounts, it does not teach having a plurality of entries as claimed. Instead, the account files of *Ryan* “correspond[] to the plurality of postage metering systems,” wherein the “data center stores reset data in each of the plurality of account files representative of reset activity associated with the plurality of postage metering systems.” See *Ryan*, ¶ [0013]. Further, the data center can “conduct[] a forensic accounting analysis of the empirical data and the reset data associated with a selected postage metering system.” *Id.* Accordingly, a combination of *Liechti* and *Ryan* would result in a metering system having a database of empirical mailing activities of individual postage meter systems and is operable only to limit the usage of a particular meter. Thus, *Ryan* fails to disclose at least this claim’s limitation, and *Liechti* is not relied upon as disclosing this limitation. Consequently, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention.

Further, the Office Action relies on *Liechti* as disclosing the parameter limiting an ability of the associated user to evidence postage using the meter. *See* Office Action, ¶ 17, page 6. Applicant respectfully disagrees and notes that *Liechti* does not disclose storing a parameter for individual users of a meter, but rather stores limits for each meter. *See Liechti*, Abstract, col. 5, lines 5-10. Accordingly, the system of *Liechti* is only capable of limiting the usage of each meter in that system, and not limiting an ability of the associated user to evidence postage using the meter, as recited by claim 1. Thus, *Liechti* fails to disclose at least this limitation, and *Ryan* is not relied upon as disclosing this limitation of claim 1 nor does it do so per the Office Action. Accordingly, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention. Therefore, Applicant respectfully asserts that for the above reasons, claim 1 is patentable over the 35 U.S.C. § 103 rejection of record.

Independent Claim 8

Claim 8, as now amended, defines a system for controlling postage usage that comprises a database for separately storing at least one postage usage parameter for each user of a plurality of users of the meter, wherein the parameter for the user limits an ability of the user associated with said parameter to evidence postage using the meter. Neither *Liechti* nor *Ryan* nor the combination of cited prior art discloses at least these limitations. The Office Action admits the *Liechti* does not teach storing a plurality of entries as claimed, and instead it relies upon *Ryan* as disclosing this feature. *See* Office Action, ¶ 26. However, this reliance is misplaced as *Ryan* fails to make such disclosure, but rather *Ryan* discusses “account files [that] correspond[] to the plurality of postage metering systems,” wherein the “data center stores reset data in each of the plurality of account files representative of reset activity associated with the plurality of postage metering systems.” *See Ryan*, ¶ [0013]. Accordingly, a combination of *Liechti* and *Ryan* would result in a metering system having a database of empirical mailing activities of individual postage meter systems and is operable only to limit the usage of a particular meter. Thus, *Ryan* fails to disclose at least this claim’s limitation, and *Liechti* is not relied upon as disclosing this limitation nor does it do so per the Office Action. Consequently, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention.

Also, contrary to the Office Action's assertion (§ 26, page 8), *Liechti* does not disclose storing a parameter for individual users of a postage meter, but rather the system of *Liechti* stores specific limits for each postage meter. *See Liechti*, Abstract, col. 5, lines 5-10. Accordingly, the system of *Liechti* is only capable of limiting the usage of each meter in that system, and not limiting an ability of the associated user to evidence postage using the meter, as recited by claim 8. Thus, *Liechti* fails to disclose at least this limitation, and *Ryan* is not relied upon as disclosing this limitation of claim 8 nor does it do so per the Office Action. Accordingly, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention. Therefore, Applicant respectfully asserts that for the above reasons, claim 8 is patentable over the 35 U.S.C. § 103 rejection of record.

Independent Claim 29

Claim 29, as amended, defines a method for controlling postage usage that includes separately storing at least one postage usage parameter for each user of a plurality of users in a postage usage database, wherein said postage usage parameters establish separate postage evidencing limits for each user of said plurality of users; (a) determining, based on the requesting user's postage usage parameter, if sufficient postage is available to fulfill the request for the requesting user; and (b) determining if sufficient postage is available from an available postage balance of a postage meter used for evidencing postage to fulfill the request for the requesting. Neither *Liechti* nor *Ryan* nor the combination of cited prior art discloses at least these limitations. The Office Action admits the *Liechti* does not teach storing a plurality of entries as claimed, and instead it relies upon *Ryan* as disclosing this feature. *See* Office Action, § 34. However, this reliance is misplaced as *Ryan* fails to make such disclosure, but rather *Ryan* discusses "account files [that] correspond[] to the plurality of postage metering systems," wherein the "data center stores reset data in each of the plurality of account files representative of reset activity associated with the plurality of postage metering systems." *See Ryan*, § [0013]. Accordingly, a combination of *Liechti* and *Ryan* would result in a metering system having a database of empirical mailing activities of individual postage meter systems and is operable only to limit the usage of a particular meter. Thus, *Ryan* fails to disclose at least this claim's limitation, and *Liechti* is not relied upon as

disclosing this limitation nor does it do so per the Office Action. Consequently, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention.

Contrary to the Office Action's assertion (§ 34, pages 9-10), *Liechti* does not disclose storing at least one postage usage parameter for individual users of a postage meter, but rather the system of *Liechti* stores specific limits for each postage meter. *See Liechti*, Abstract, col. 5, lines 5-10. Accordingly, the system of *Liechti* is only capable of limiting the usage of each meter in that system; hence, there can be no separate postage evidencing limits for each user, as recited by claim 29. Thus, *Liechti* fails to disclose at least this limitation, and *Ryan* is not relied upon as disclosing this limitation of claim 29 nor does it do so per the Office Action. Therefore, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention.

Moreover, *Liechti* does not disclose determining, based on the requesting user's postage usage parameter, if sufficient postage is available to fulfill the request for the requesting user, as recited by claim 29. The Office Action asserts that *Liechti*'s termination of the meter's ability to evidence postage when the ascending register reaches the postage amount limit describes this limitation of claim 29. *See* Office Action, § 5. However, this reliance is misplaced as *Liechti* does not explicitly teach a determination step based on the postage limit of a user out of a plurality of users. Even if this determination is to be implied, then *Liechti*'s determination would be based on the meter's postage limits and not on the postage limits of a user among a plurality of users of a meter, as required by claim 29. *Liechti* plainly states that "the value of the ascending register may not exceed the postage amount limit . . . , and [t]he meter becomes inoperative as soon as the ascending register value is greater or equal to the postage limit. Only by connection of the meter to data center 15, may a new postage amount limit be established." *See Liechti*, col. 5, lines 22-28. Accordingly, in *Liechti*, when the meter's postage limit is reached, it is determined that the meter – not the requesting user – does not have sufficient postage available. Therefore, nothing in *Liechti* teaches performing a determination based on a parameter associated with a particular user out of a plurality of users of a meter. *Ryan* is not relied upon as disclosing this limitation of claim 29 nor does it do so per the Office Action. Consequently, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention. Therefore,

Applicant respectfully asserts that for the above reasons, claim 29 is patentable over the 35 U.S.C. § 103 rejection of record.

Claims 2-5, 7, 9-11, 13, and 30-37 all depend from base claims 1, 8, and 29, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-5, 7, 9-11, 13, and 30-37 sets forth features and limitations not recited by the combination of *Liechti* and *Ryan*. Thus, the Applicant respectfully asserts that for the above reasons claims 2-5, 7, 9-11, 13, and 30-37 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Moreover, dependent claims 2-5, 7, 9-11, 13, and 30-37 set forth limitations making them patentable in their own right. For example, dependent claims 2-4, 9-11, and 32 further recite the various parameters as a maximum postage amount that a user of said plurality of users is allowed to use on the meter, a period of time during which a user of said plurality of users is allowed to use on the meter, and a maximum postage amount that a user of said plurality of users is allowed to use on a meter over a selected period of time. Applicant points out that *Liechti* and *Ryan* fail to satisfy these limitations. Instead, *Liechti* imposes a postage amount limit, a time limit, and a piece limit on each meter, wherein these limits restrain the meter's ability to evidence postage if any one of these limits is reached by the meter. These limits on a meter's ability to evidence postage are simply not the same as a parameter, which is associated with a user among a plurality of users of a meter, controlling whether or not the user associated with the parameter can evidence postage on that meter. Accordingly, *Liechti* does not disclose these parameters which include a maximum postage amount of a user of said plurality of users, a period of time during which such user is allowed to use the meter, and a maximum postage amount over a selected period of time such user is allowed on the meter. *Ryan* is not relied upon as disclosing these features, nor does it do so. Therefore, Applicant respectfully asserts that for the above reasons claims 2-5, 7, 9-11, 13, and 30-37 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Lack of Rationale

The Office Action admits that *Liechti* does not teach having various limitations of the claims. The Office Action attempts to cure this deficiency by introducing *Ryan*, which the

Office Action alleges to teach such limitations. The rationales for making the combination are presented as follows:

It would have been obvious . . . to have modified the meter of *Liechti* to have included storing a plurality of entries wherein each entry is associated with a user of the plurality of users as taught by *Ryan* for the advantage of providing a flexible postage metering system that can process mail for a plurality of customers. Office Action, ¶ 20.

[I]t would have been obvious . . . to include in the postage system of *Liechti* the ability to store a plurality of entries, wherein each entry is associated with a user . . . as taught by *Ryan* since the claimed invention is merely a combination of old elements, and in combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *Id.*

It is well settled that to facilitate review, the obvious rejection analysis should be made explicit. *See KSR*, 127 S.Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). Furthermore, Applicant notes that the Supreme Court further stated that “As is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* Thus, that it is “important [for an examiner] to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *Id.* Indeed, the Supreme Court indicated that there should be an “explicit” analysis regarding “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.*

The Office Action does not provide any rational analysis as to the rationale supporting the rejection. The Office Action merely provides conclusory statements without any supporting analysis that details any articulated reasoning. In general, Applicant notes that

Liechti already provides a flexible postage metering system that can process mail for a plurality of customers, each of which possess a postage metering system. There is no need to combine *Liechti* with *Ryan* to achieve this result.

Further, Applicant notes that simply stating in mere conclusory statement that the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as did separately, is neither a proper “explicit analysis” as required by *KSR* nor an appropriate reasoning as a rationale must establish an articulated reasoning with some rational underpinning. Therefore, the rejection of claims 1-5, 7-11, 13, and 29-37 should be withdrawn.

Rejection Under 35 U.S.C. § 103

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Liechti* in view of *Ryan* and further in view of U.S. Publication No. 2004/0194154 to Meadors et al. (“*Meadors*”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy the third criteria.

Base claim 1 is defined as described above. Neither *Liechti* nor *Ryan* discloses these limitations, as discussed above. *Meadors* is not relied upon in the Office Action as disclosing these limitations, and does not teach these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claim 6 depends from base claim 1, and thus inherit all limitations of its base claim. Claim 6 sets forth features and limitations not recited by the combination of *Liechti*, *Ryan*,

and *Meadors*. Thus, the Applicant respectfully asserts that for the above reasons claim 6 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Rejection Under 35 U.S.C. § 103

Claims 12, 15-22, and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Liechti* in view of *Ryan* and further in view of U.S. Publication No. 2004/0098354 to Manduley (“*Manduley*”).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding the first and second criteria, Applicant asserts that the rejection does not satisfy the third criteria.

Base claim 8 is defined as described above. Neither *Liechti* nor *Ryan* discloses these limitations, as discussed above. *Manduley* is not relied upon in the Office Action as disclosing these limitations, and does not teach these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Independent Claim 15

Claim 15 defines a system for controlling postage usage that comprises at least two postage evidencing meters with at least one postage evidencing meter of said at least two postage evidencing meters separately storing at least one postage usage parameter for each user of a plurality of users, wherein said postage usage parameters define different postage evidencing limits with respect to each user of said plurality of users. The combination of *Liechti*, *Ryan*, and *Manduley* does not disclose at least these limitations. The Office Action admits the *Liechti* does not teach storing a plurality of entries as claimed and does not rely upon *Manduley* as disclosing this feature, nor does *Manduley* do so. Instead, the Office Action relies upon *Ryan* as disclosing this feature. However, this reliance is misplaced as *Ryan* fails to make such disclosure, but rather *Ryan* discusses “account files [that]

correspond[] to the plurality of postage metering systems,” wherein the “data center stores reset data in each of the plurality of account files representative of reset activity associated with the plurality of postage metering systems.” *See Ryan*, ¶ [0013]. Accordingly, a combination of *Liechti* and *Ryan* would result in a metering system having a database of empirical mailing activities of individual postage meter systems and is operable only to limit the usage of a particular meter. Thus, *Ryan* fails to disclose at least this claim’s limitation, and *Liechti* is not relied upon as disclosing this limitation nor does it do so per the Office Action. Consequently, the combination of *Liechti* and *Ryan* does not disclose all elements of the claimed invention.

Also, contrary to the Office Action’s assertion (¶ 54, page 15), *Liechti* does not disclose storing a parameter for individual users of a postage meter, but rather the system of *Liechti* stores specific limits for each postage meter. *See Liechti*, Abstract, col. 5, lines 5-10. Accordingly, the system of *Liechti* is only capable of limiting the usage of each meter in that system, and not limiting an ability of the associated user to evidence postage using the meter, as recited by claim 8. Thus, neither *Liechti* nor *Ryan* discloses these limitations, and *Manduley* is not relied upon disclosing these limitations nor does it do so per the Office Action. Therefore, the combination of references does not teach all elements of the claimed invention.

Claims 12, 16-22, and 38 depend from base claims 8, and 15, respectively, and thus inherit all limitations of its base claim. Claims 12, 16-22, and 38 set forth features and limitations not recited by the combination of *Liechti*, *Ryan*, and *Manduley*. Thus, the Applicant respectfully asserts that for the above reasons claims 12, 16-22, and 38 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Moreover, dependent claims 12, 16-22, and 38 set forth limitations making them patentable in their own right. For example, dependent claims 16-18, further recite the various parameters as a maximum postage amount that a user of said plurality of users is allowed to use on the meter, a period of time during which a user of said plurality of users is allowed to use on the meter, and a maximum postage amount that a user of said plurality of users is allowed to use on a meter over a selected period of time. Applicant points out that *Liechti*,

Ryan, and *Manduley* fail to satisfy these limitations. Instead, *Liechti* imposes a postage amount limit, a time limit, and a piece limit on each meter, wherein these limits restrain the meter's ability to evidence postage if any one of these limits is reached by the meter. These limits on a meter's ability to evidence postage are simply not the same as a parameter, which is associated with a user among a plurality of users of a meter, controlling whether or not the user associated with the parameter can evidence postage on that meter. Accordingly, *Liechti* does not disclose these parameters which include a maximum postage amount of a user of said plurality of users, a period of time during which such user is allowed to use the meter, and a maximum postage amount over a selected period of time such user is allowed on the meter. Neither *Ryan* nor *Manduley* is relied upon as disclosing these features, nor do they do so. Therefore, Applicant respectfully asserts that for the above reasons claims 12, 16-22, and 38 are patentable over the 35 U.S.C. § 103(a) rejection of record.

CONCLUSION

In view of the above, applicant believes the pending application is in condition for allowance.

Please charge any fees required or credit any overpayment to Deposit Account No. 06-2380, under Order No. 61135/P023US/10303235 during the pendency of this Application

Application No. 10/679,861
Reply to Office Action of June 25, 2008

Docket No.: 61135/P023US/10303235

pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: September 25, 2008

Respectfully submitted,

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Date of Transmission: September 25, 2007